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Bon-Chul Koo

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BLAKELY SOKOLOFF TAYLOR & ZAFMAN

1279 OAKMEAD PARKWAY

SUNNYVALE, CA 94085-4040

EXAMINER

KHAN, ASIF H

ART UNIT

PAPER NUMBER

4183

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/509,526

Applicant(s)

KOO, BON-CHUL

Examiner

Asif H. Khan

Art Unit

4183

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on September 17, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 10-2000014916, filed on March 20, 2002.

Objections

Abstract

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Specification

3. The disclosure is objected to because of the following informalities:

Page 2, line 16, "Intergraded" should be "Integrated"

Page 2, line 35, "constitution" should be "'constituting".

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Page 4, line 8, "rout" should be "route".

Page 6, line 25 "form" should be "from". The same correction is also needed on page 7, line 9.

Page 11, line 16 "RIB 307" is an incorrect reference and should be changed to "RIB 305".

The term "PMS" used multiple times in the disclosure needs to be spelled out since it is not a commonly used acronym in the relevant art.

Page 3, lines 31-33, the distinction is not clear between "ATM at a physical layer is applied" and "the ATM is applied".

Page 9, line 10 the function performed is not clear by "forcibly execute the ADSL modem".

Page 6, line 6, the term "ATM pool number" (used multiple times elsewhere in the disclosure) has not been defined.

Page 10, line 13, the term "ATM header pool" has not been adequately explained.

Appropriate correction is required.

Claim Objections

4. Claim 1 is objected to because of the following informalities:

Page 13, line 17, "allocated" should be "allocate"

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, "asynchronous transfer mode (ATM) pool number" is not precisely defined in the specification and it's linking with the ID number of the access-requested terminal is ambiguous.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Kobayashi (Pub. #US 2001/0004361).

Regarding claim 1, Kobayashi teaches a telephone controller for Internet-based phone service connected thru a digital transmission technology (see e.g. Summary

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[0009] (*"An apparatus for a web-phone service in a digital subscriber line (DSL)"*), comprising:

a memory for storing and managing a table of Identification Numbers (IDs) of phones (terminals) (Summary, [0011]) (*"a memory means for storing and managing an identification number (ID) number of a terminal"*);

a communication means for the access-requesting telephone connecting via the network, for receiving the ID number associated with the IP address of the access-requested telephone from the memory storing the ID numbers (see e.g. [0027], lines 1-6)(*"a transmission means for retrieving an ID number of an access-requested terminal from the memory means when the access-requesting terminal requests a web-phone service"*), the IP control circuit directing the IP allocation circuit to output an IP address that is associated with the ID number of the telephone, to the access-requesting terminal (see e.g. [0027], lines 6-13 and lines 16-19)(*"transmitting the ID number of the access-requested terminal to an Internet protocol. (IP) control means, receiving an allocated IP address of the access-requested terminal from the IP control means and transmitting the allocated IP address to the access-requesting terminal"*);

the IP control circuit 110 retrieves the table 131 (see Fig.1), for determining the IP address of the access-requested telephone and acquires the IP address from the IP address allocating circuit 122 to assign it to the access-requested phone (terminal) which does not have an IP address already assigned (see e.g. [0025], lines 3-5 and 8-9)(*"the IP control means for determining whether an IP address is allocated to the access-requested terminal and controlling an IP address allocation means to allocate an*

available IP address to the access-requested terminal which does not have an assigned IP address”);

the ID number of the access-requested phone is associated with the extension phone # (corresponds to the ATM pool number), and the IP address allocating circuit provides an available IP address to the access-requested phone without an assigned IP address, (see e.g. [0025], lines 9-11 and [0038], lines 4-7)(“ *by using an asynchronous transfer mode (ATM) pool number corresponding to the ID number of the access-requested terminal; and the IP address allocation means for allocating an available IP address to the access-requested terminal which does not have an assigned IP address and reporting the allocated IP address to the IP address controlling means*”).

Regarding claim 4, incorporating the rejection of claim 1, Kobayashi teaches the IP control circuit 110 of the telephone controller outputs an IP address allocation instruction to the IP address allocating circuit 122, upon which it creates an IP Address not used in the phone (terminal) (see e.g. [0027], lines 7-11], which corresponds to the extension telephone number linked to the ID number, the created entry being stored in the data structure of table 131 [0027, lines 17-21]. The ID number is sent thru a packet in response to the access-requesting communication protocol. (see e.g. [0027], lines 1-4, and [0038], lines 1-7] (“*wherein the IP control means controls the IP address allocation means to forcibly allocate an available IP address, which is not used in the terminal, by using an ATM header pool number corresponding to the ID number, extracts the IP address, stores the IP address as a form of database and returns the ID number upon an access request from the transmitting means*”).

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9. Claims 5, 7-9 are rejected 25 U.S.C. 102(e) as being anticipated by Dynarski et al. (US Patent #6,272,129), hereinafter referred to as Dynarski.

Regarding claim 5, Dynarski teaches a method of locating and connecting a mobile wireless communication device on a network, accessed from a remote terminal (see e.g. col. 6, lines 54-48), by extracting a machine identification number (MIN) associated with the mobile device ("access-requested terminal") from a mobile node location server (PND) (col. 7, lines 40-43 and 45-47) and transferring the MIN to another server also referred to as a Foreign Agent (RIB), (col. 7 line 67- col. 8, line 2), in response to an Access Request message received from the remote terminal; *("A method for a web-phone service in a DSL, comprising the steps of:*

a) extracting a machine identification number (MIN) of an access-requested terminal from a phone number domain (PND) and transferring the MIN to a requested IP broker (RIB) when a terminal requests an access to the web-phone service");

checking a table used for mapping IP addresses to machine identification numbers, if a useable IP address has been assigned for accessing the mobile node ("access requested terminal") at the server (RIB) (col. 7, lines 45-53);

(" b) determining whether an IP address is allocated to the access-requested terminal at the RIB");

initiating a connection with the Network Access Server (NAS) to allocate the IP address for connection of the mobile node to the network, the IP address being mapped to unique identifiers ("ATM pool number") related to the machine identification numbers (MIN) (see e.g. col. 8, lines 9-13 and col. 7, lines 40-43);

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("c) controlling a network access server (NAS) to allocate an IP address to the access-requested terminal by using an ATM pool number corresponding to the MIN of the access-requested terminal in case that the IP address is not allocated to the access-requested terminal");

the IP address of the mobile node ("access-requested terminal") is forwarded from the Foreign Agent (RIB) to the mobile node location server (RIB) to establish a connection from the mobile node to the remote terminal (see e.g. col. 7, line 67-col. 8, line 2)

(" and d) transferring the allocated IP address of the access-requested terminal from the RIB to the access- requesting terminal through the PND to establish a connection between the access-requesting terminal and the access-requested terminal").

Regarding claim 7, The Network Access Server is connected thru the network to another server (RIB) to which it can transfer the available IP address that is mapped to unique identifiers ("ATM pool number") for the mobile node ("access requested terminal")(see e.g. col. 8, lines 41-51)

("The method as recited in claim 5 wherein at the step b), if the access-requested terminal does not have an allocated IP address, at the step c), the NAS is controlled to allocate an available IP address to the access-requested terminal by using an ATM pool number corresponding to the MIN of the access-requested terminal and the NAS transfers the IP address to the RIB").

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Regarding claim 8, the available IP address of the mobile node is forwarded from the Foreign Agent (RIB) to the mobile node location server (PND) to establish a connection from the mobile node to the remote terminal (see e.g. col. 7, line 67-col. 8, line 2) when the mobile node ("access requested terminal") already has an IP address assigned.

("The method as recited in claim 5, further comprising the step of:

e) transferring the allocated IP address of the access-requested terminal from the RIB to the access- requesting terminal through the PND and establishing a connection between the access-requesting terminal and the access-requested terminal in case that the access-requested terminal already has an allocated IP address at the step b)").

Regarding claim 9, the Foreign Agent (RIB) controls the Network Access Server (NAS) to assign an available IP address that is mapped to the machine identification numbers. The use of a dynamic call database storing the machine identification numbers (that correspond to the available IP addresses) that can be looked up to find the records when an access request is made (activate the call) is also taught by Dynarski (see e.g. col. 13, lines 35-42).

"The method as recited in claim 5, wherein the RIB controls the NAS to forcibly allocate an available IP address, which is not used, extracts IP address according to the MIN of the user, and stores the IP address as a form of database so as to return the IP address upon an access request of the PND").

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Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi, in view of Mattaway et al. (US Patent 6,272,129), herein after referred to as Mattaway.

Kobayashi discloses the claimed invention above, but fails to disclose that the apparatus for web-phone service includes a Web Server or the access-requesting terminal is an Internet content terminal.

However, Mattaway in an analogous art teaches a Web Server 260 (see col. 9, lines 46-53) storing and managing contents of Internet content providers (see col. 6, lines 48-52), as well as a terminal (computer system) connected on the network

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providing Internet contents (see e.g. col. 9, lines 62-65), for the purpose of sharing Internet data over a digital communications link.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the applicant's invention was made to combine a Web Server and an access-requesting Internet content terminal taught by Mattaway, within the network setup disclosed by Kobayashi to provide web-based contents as an enhancement to the functionality of the Web-phone system.

13. Claims 6, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dynarski, in view of Mattaway.

Regarding claim 6, Dynarski discloses the claimed invention above but fails to disclose that the access-requesting terminal is an Internet content terminal.

However, Mattaway in an analogous art teaches a terminal (computer system) connected on the network providing Internet contents (see e.g. col. 9, lines 62-65), for the purpose of sharing Internet data over a digital communications facility.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the applicant's invention was made to combine Internet contents functionality of an end terminal taught by Mattaway, to the remote terminal disclosed by Dynarski, to provide an attractive web-content feature in a connecting terminal.

Regarding claims 10 and 11, Dynarski teaches all the limitations of the claimed method, but fails to disclose the use of a computer readable recording medium.

However, Mattaway teaches the implementation of embodiments comprising a series of instructions on computer readable media on a computer system (a

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microprocessor being an inherent part of it)(col. 11, lines 57-62), for the purpose of providing an alternate method of implementation which is portable and adaptable.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the applicant's invention was made to combine computer readable medium including a microprocessor (use of a computer system) taught by Mattaway, to the method disclosed by Dynarski, to provide portable and adaptable computer-based functionality of the Web-Phone service.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Asif H. Khan whose telephone number is (571) 270-1955. The examiner can normally be reached on Monday to Thursday: 7:30 AM to 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Len Tran can be reached on (571) 272-1184. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Asif H. Khan
Patent Examiner
AU 4189

October 9, 2007



Supervisor LENTRAN
PRIMARY EXAMINER
10/12/07